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09/931,817	08/16/2001	Stephen M. Bull	BUL-001	3311

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/931,817
Filing Date: August 16, 2001
Appellant(s): BULL, STEPHEN M.

MAILED
SEP 25 2006
GROUP 3700

Jeanette Harms
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1 September 2006 appealing from the Office action mailed 10 April 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,320,495

Sporgis

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Sporgis (US Patent Number 6,320,495).

Claim 25: Sporgis teaches a method of providing a game that creates awareness of at least one sponsor including providing one or more game spaces (Fig 4). Sporgis teaches advertising by sponsors. Advertising creates awareness of a sponsor. In each game space, players are provided with clues that may be on any subject (including an advertising object). Sporgis states that an endless variety of clues can be transmitted – this inherently includes advertising objects. (Col 3, 44-51) (Note: Advertising objects are a subset of all possible clues (i.e., an endless variety of clues).) Applicant's specification makes it clear that interacting with a clue may merely involve reading the clue and attempting to solve it. Clearly, Sporgis teaches reading the clues and attempting to solve them. Thus Sporgis teaches interacting with the clue, which may be an advertising object and which would inherently create awareness of the sponsor. Upon solving the clue, a player is directed to proceed from one game space to another game space. (Col 2, 50 – Col 3, 18) Sporgis states that commercial sponsors may support the game in exchange for advertising rights. (Col 3, 21-23) Thus either Sporgis inherently has at least one advertising object in each game space (i.e., as a clue), or it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sporgis to have at least one advertising object in each game space in order to carry out the suggestion that commercial sponsors may support the game in exchange for advertising rights.

Claim 26: Knowledge of the game spaces is communicated to players located in a cell zone of the game space. The clues are provided depending on a player's location. (Col 3, 8-13)

Claims 27 & 28: Sporgis teaches providing the at least one clue is accomplished in a cross-channel manner using a cellular telephone. (Col 2, 1-11)

(10) Response to Argument

Throughout the prosecution of the case, Appellant has never argued that the structure of the game taught by Sporgis is different from the structure of the claimed game. Nor does Appellant do so in this appeal. Appellant argues that the games are patentably distinct because the clues are different. This is tantamount to arguing that Trivial Pursuit, Movie Edition is patentably distinct from Trivial Pursuit, Original Edition because the clues are different.

Clearly, this is not the case. One cannot distinguish over a prior art game involving clues by changing the clues. If one could do so, then a patent would offer no protection.

Be that as it may, Sporgis does teach Appellant's invention -- including having advertising as clues. A reference anticipates a claimed invention if the claim is a subset of the material taught by the reference. In this case, Sporgis teaches that the clues may be of an endless variety -- i.e., on any topic. Clearly, "advertising clues" are a subset of an "endless variety" of clues.

Appellant argues that Examiner is to ignore this disclosure of an "endless variety of clues" because it is "boilerplate". Examiner can find nothing in the MPEP that either directs or allows Examiners to ignore part of the specification of a reference because it is "boilerplate". Nor has Appellant cited any authority for his contention that it is permissible to ignore any part of the specification. Examiner contends that absent some direction from the Office, he is not entitled to ignore any part of the specification of a reference. Furthermore, Examiner does not believe this to be "boilerplate". Sporgis is stating a simple truth -- the clues can be on any topic.

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Just as Trivial Pursuit may have different editions with different clue sets, so may Sporgis's game. The contents of the clues cannot serve to patentably distinguish over the disclosed game since they are nothing more than printed matter.

Furthermore, even if the Examiner could pick and choose which portions of a reference he could ignore, it would have been obvious to have advertising clues as part of Sporgis's game. Sporgis teaches the desirability of having sponsors for the game. These sponsors support the game in order to gain awareness of their products and services. As Appellant points out, these sponsors cannot effectively advertise their products and services unless the advertisements are embodied in the clues. Since advertisers will not pay for ineffective advertising, it would have been obvious to one of ordinary skill in the art at the time of the invention to have made the clues advertising clues in order to produce effective advertising, thus attracting the sponsors Sporgis teaches are so desirable.

Since Sporgis teaches clues that include advertising clues and since the use of advertising clues is obvious from Sporgis's disclosure and since in any case, the content of the clues cannot patentably distinguish Appellant's game over the prior art, Examiner asks that the rejection of the claims be sustained.

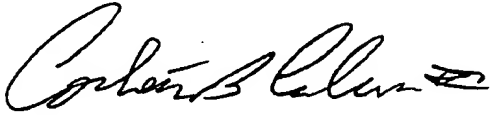
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

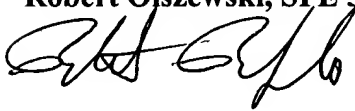
Respectfully submitted,



**CORBETT B. COBURN
PRIMARY EXAMINER**

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Robert Olszewski, SPE 3714



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